



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,449	03/30/2001	Tg Hien	3COM-3228.US.P	5704

7590 10/24/2003

WAGNER, MURABITO & HAO LLP  
Third Floor  
Two North Market Street  
San Jose, CA 95113

EXAMINER

ST CYR, DANIEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/823,449

Applicant(s)

HIEN ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 7/28/03.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 10-13, 15, 16, 21-23, are rejected under 35 U.S.C. 102(b) as being anticipated by Harari et al, US Patent No. 5,887,145.

Re claims 1, 10, and 21, Harari et al discloses a removable mother/daughter card comprising: a first module 10 (the card serves as a communication device) having an opening, said first module adapted to be communicatively coupled with an electronic device 200, said first module adapted to receive a second module 20; a controller 40 coupled with said first module for controlling communication between said first and second module; a first module electrical connector 12 to communicate with said electronic device; and a second connector coupled with the first module for communicating with the second module (see figures 1-3 and col. 6, line 59 +).

Re claims 2, 11, and 22, wherein the first module is adapted to be inserted into said accessible slot of said electronic device (see figure 1).

Re claims 3 and 12, wherein said opening of said first module is adapted to receive said module (see figure 1).

Art Unit: 2876

Re claim 4, 13, 23, wherein said first and second modules are communication memory devices (figure 3).

Re claims 15 and 16, wherein the memory device is digital multimedia card (see figure 4).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. The teachings of Harari et al have been discussed above.

Harari et al fails to disclose or fairly suggest that the opening of the first module is larger than accessible slot of electronic device. However, such limitation is an obvious engineering design choice to meet customers' requirements, failing to provide any unexpected results.

Art Unit: 2876

Furthermore, these types of connection combinations are notoriously old and well known in the art. Therefore, it would have been an obvious extension as taught by Harari et al.

7. Claims 6-8 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al in view of Nelson et al, US Patent No. 6,377,218. The teachings of Harari et al have discussed above.

Harari et al teach that the communication device could be a modem (see col. 8, line 45), but fail to disclose or fairly suggest that the modem is a Bluetooth wireless modem.

Nelson et al disclose a device for providing an antenna, a receptacle, and physical connector on a type II PCMCIA card comprising a radio frequency device 200 wherein the device is Bluetooth wireless device (see col. 3, line 60+ and col. 4, line 34+).

In view of Nelson et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the modem device of Harari et al into a Bluetooth wireless modem to provide connection to remote network. Such modification would facilitate connection to existing data networks by providing a bridge mechanism to interface with the data networks. Furthermore, the Bluetooth modem would able to process communication inquiries and requests without involving the host system, which would make the system more effective. Therefore, it would have been an obvious extension as taught by Harari et al.

#### ***Response to Arguments***

8. Applicant's arguments filed 7/28/03 have been fully considered but they are not persuasive. (see the examiner remarks).

#### **REMARKS:**

In response to the applicant's first argument that the first module is not a communication device, the examiner respectfully disagrees. The first module 10 communicates to host computer and second module 20, and is used as a communication device so that the second module communicates with the host device 200 (see figure). Furthermore, memory cards are communication devices. The applicant's first argument is not persuasive.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Harari et al disclose the daughter card 20 could be a modem or other communication peripherals wherein an artisan would recognize the benefit of using a wireless modem to communicate between the first and the second module. In the case when a wireless is used, modification of the first module would be required wherein wireless circuits, such as antenna circuits would be needed to communicate with the second module. Therefore, it would have been obvious extension as taught by Harari et al. The applicant's second argument is not persuasive. Refer to the rejection above.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2876

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', with a long horizontal line extending to the right.

DS  
October 20, 2003